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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,224	06/25/2003	Thomas S. Murphy	3317.126 US1	4383
23483	7590	12/14/2006	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE STREET BOSTON, MA 02109			DESAI, ANISH P	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/603,224	MURPHY ET AL.
	Examiner	Art Unit
	Anish Desai	1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 September 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 and 12-28 is/are pending in the application.
- 4a) Of the above claim(s) 18-27 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-10, 12-17, and 28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

The Request for Continued Examination (RCE) by the applicant is received on 09/21/06 and is fully considered.

1. Claims 1-10 and 12-28 are pending. Claim 11 is cancelled. Claims 19-27 are withdrawn. Claim 28 is a new claim. Support for amended claims and newly added claim 28 is found in the specification.
2. 112 rejections are moot in view of the present amendment and response (see pages 2-3 of 08/18/06 amendment).
3. 103 type rejections of Schneler et al. (US 2,740,403) in view of Murphy et al. (US 5,762,623) are maintained, except the evidenced reference of US 5,914,282 is withdrawn because claims 4 and 5 require only one material selected from the group consisting of woven, knit and non-woven fabrics as porous backing. 103 type rejections taken alone in view of Schneler is withdrawn in favor of 102/103-type rejection.
4. Obviousness type double patenting rejection is made in view of S/N 11/204,736.

Claim Objections

5. Claims 1-3 are objected to because of the following informalities: Claims 1, 2, and 3 recite "a porous backing substrate that is greater than about 25% open area in structure". The phrase "structure" is redundant because it does not impart any additional structural limitation to the porous backing substrate, thus the examiner suggests deletion of the phrase "structure".
6. Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is

required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 14 recites "The article of claim 2, wherein the adhesive penetrates into about 25% to 75% of the thickness of the backing substrate". Claim 2 already discloses penetration of the adhesive into about 25% to 75% of the thickness of the backing substrate.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4-10, 12, 13, 15-17, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneler et al. (US 2,740,403) in view of Murphy et al. (US 5,762,623).

Schneler teaches adhesive bandages for medical and surgical purpose (Column 1, line 15-16). The adhesive bandage of Schneler is a two-ply bandage containing a backing, which is made from a porous fabric and another thickness (known as carrier) made of an open mesh fabric that is impregnated or coated with an adhesive in such

manner that the fabric remains substantially porous (Column 1, lines 22-33). The carrier of Schneler is adhered to one surface of the backing to form two-ply bandage (Column 1, line 33-34). The examiner is equating the carrier of Schneler as an adhesive-carrying fabric as claimed and the porous backing of Schneler as a porous backing substrate as claimed.

With respect to claims 4 and 5, Schneler discloses the backing can be a woven material (Column 1, line 26) and carrier (adhesive-carrying fabric) can be formed from woven and knitted materials (Column 1, lines 57-58). With respect to claim 8, Schneler discloses that the backing and carrier (adhesive-adhesive carrying fabric) of the two-ply bandage are elastic and extensible in one or both directions (Column 1, lines 40-42, Column 3, lines 3-6). Regarding claims 13 and 14, although Schneler does not explicitly teach penetration of adhesive into the surface of the porous backing substrate (claim 13) and adhesive has sufficiently internal strength that the article is removable from a substrate without separation of the backing substrate and the adhesive-carrying fabric (claim 14), however since the structure of the adhesive bandage of Schneler is same as claimed by the applicant (e.g. porous backing in contact with a porous fabric carrying adhesive), therefore the adhesive of Schneler would inherently penetrate into the porous backing and the adhesive of Schneler would inherently have sufficient internal cohesive strength such that the adhesive bandage of Schneler would be removable from a substrate without separation of the backing and the carrier layer (adhesive carrying fabric) (Note reliance upon inherency is not improper even though

the rejection is based on Section 103 instead of Section 102 (*In re Skoner*, et al. (CCPA) 186 USPQ 80).

With respect to properties of porous backing comprises greater than about 50% open area (claims 1 and 12), adhesive-carrying fabric being at least about 50% open area (claim 1), adhesive-carrying fabric comprises more than 80% open area prior to the application of the adhesive (claim 9), % open area of the adhesive-carrying fabric is reduced by no more than about 10% upon application of the adhesive (claim 10), and adhesive-carrying fabric located on the fabric in such a manner that the fabric remain more porous than the backing substrate (claim 1), however it is reasonable to presume that said properties are necessarily present in invention of Schneler, because like material have like properties. The invention of the applicant is described in claim 1. Schneler discloses an adhesive bandage with a porous backing wherein the porous backing of Schneler has opening of some 0.005 in between adjacent yarns (column 2, lines 42-46). Further the porous backing of Schneler is bonded to an adhesive impregnated carrier layer which is formed of a more openly woven fabric which has opening of some 0.01 in (column 2, lines 48-54). Additionally, Schneler discloses that the carrier layer (adhesive-carrying fabric) although impregnated still remains a porous structure (column 1 lines 57-66, column 2 lines 13-14 and lines 48-53). Therefore, the presently claimed properties would have been present (*In re Fitzgerald* 205 USPQ 594).

With respect to claim 17, the claim limitation of elastic yarns is interpreted as yarns that are stretchable (elastic) and Schneler discloses that both porous backing and

carrier layer are elastic (column 1 lines 27-28, column 2 lines 70-72 and column 3 lines 1-2).

Schneler is silent as to teaching of adhesive-carrying fabric having tensile strength in cross direction that is greater than the tensile strength in the machine direction (claim 1), adhesive-carrying fabric comprises a warp knit fabric wherein warp knit fabric comprises a weft insert yarn (claims 6 and 7), the article tears uniformly in cross machine direction (claim 16), and adhesive-carrying fabric has a warp/weft threat count ranging from about 18*12 to about 9*12 yarns/inch (claim 28). However, Murphy teaches a laminated tape/bandage comprising a layer of transversely-spaced, longitudinally-extending elastic strands between a pair of outer layers, at least one of which is a warp-knitted (weft insertion) fabric oriented with knit yarns extending longitudinally and generally parallel to the orientation of the elastic strands (see Abstract). Further Murphy teaches that the laminated tape/bandage is light, comfortable to wear, can be easily torn transversely by hand and when so torn tears cleanly substantially perpendicularly across the width of the tape/bandage (column 3, lines 19-25). Additionally Murphy discloses warp weft thread count of 18*16 (column 2, line 46).

The warp-knitted (weft insertion) fabric layer of Murphy is shown in Figure 3 of Murphy et al., wherein the fabric is oriented so that knitted warp yarns 50 extend generally from the left to right and the loose of non-twisted weft yarns 60 extend vertically (Column 3, lines 41-44). The knitted warp yarns are 45 denier made of polyester and weft yarns are 150 denier made of polyester (Column 2, lines 47-49). The examiner is equating the direction of warp yarns to be in the machine direction and

the direction of fill or weft yarns to be in the cross machine direction (cross direction).

Note that the knitted warp yarns of 45 denier of Murphy necessarily have lower tensile strength than 150 denier weft yarns of Murphy because of different yarn size.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the warp-knitted (weft insertion) fabric of Murphy in the invention of Schneler as a carrier layer (adhesive-carrying fabric), motivated by the desire to create adhesive bandage that is light, comfortable to wear, and can be easily torn transversely by hand and when so torn tears cleanly substantially perpendicularly across the width of the adhesive bandage.

With respect to claim 28, Schneler as modified by Murphy teaches claimed invention except the threat count of adhesive-carrying fabric in the range of 18*12 yarns per inch to about 9*12 yarns per inch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the adhesive-carrying fabric with tread count in the range of 18*12 yarns per inch to about 9*12 yarns per inch, since it has been held that discovering an optimum value of a result effective variable involves only route skill in the art (*In re Boesch*, 617 F. 2d 272, 205 USPQ 215 CCPA 1980).

8. Claims 2, 3, and 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schneler et al. (US 2,740,403). The invention of Schneler is previously disclosed. Schneler teaches claimed invention except the porous backing substrate that is greater than about 25% open area in structure (claims 2 and 3), adhesive-carrying fabric being at least about 50% open area

in structure (claims 2 and 3), adhesive of the adhesive-carrying fabric located on the fabric in such a manner that the adhesive-carrying fabric remains porous and the adhesive penetrates into about 25% to about 75% of the thickness of the porous backing (claims 2 and 14). However, it is reasonable to presume that said properties are necessarily present in invention of Schneler, because like material have like properties. The invention of the applicant is described in claim 3. Schneler discloses an adhesive bandage with a porous backing wherein the porous backing of Schneler has opening of some 0.005 in between adjacent yarns (column 2, lines 42-46). Further the porous backing of Schneler is bonded to an adhesive impregnated carrier layer which is formed of a more openly woven fabric which has opening of some 0.01 in (column 2, lines 48-54). Additionally, Schneler discloses that the carrier layer (adhesive-carrying fabric) although impregnated still remains a porous structure (column 1 lines 57-66, column 2 lines 13-14 and lines 48-53). Therefore, the presently claimed properties would have been present (*In re Fitzgerald* 205 USPQ 594 and *In re Best*, 195 USPQ at 433, footnote 4 CCPA 1977).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-10, 12-17, and 28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17, 22, 28-30, 33-41, 43-62, 67, 70, and 71 of copending Application No. 11/204,736. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-10, 12-17, and 28 encompasses the same subject matter as disclosed by claims 1-17, 22, 28-30, 33-41, 43-62, 67, 70, and 71 of S/N 11/204,736.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

10. Applicant's arguments filed on 08/16/06 have been fully considered but they are not persuasive.

The applicant argues that the upper ply of Schneler as disclosed in the Figures 2 and 5 are too closed in structure to maintain sufficient porosity after being laminated to the lower play structure as shown in Figure 3 (page 8 of 08/16/06 amendment). The examiner respectfully disagrees. Note that Schneler teaches the backing can also be made from woven acetate rayon yarn or other thermoplastic yarn and by hot

calendaring, swelling with solvent or similar treatment, caused to close to some extend the open mesh of the weave to leave the necessary minute openings for porosity and for resisting the penetration of dirt from the exterior (column 4, lines 1-6).

The applicant argues that Schneler further fails to teach a lower ply layer that is sufficiently open in structure to provide the breathability of the applicant's invention.

The applicant asserts that his/her specification describes much more open layer that can be up to about 95% open and is typically at least about 50% open, which corresponds to in an exemplary embodiment to a warp/weft count thread ranging from about 18*12 to about 9*12 (page 8 of 08/16/06 amendment). The examiner respectfully disagrees. The examiner recognizes that Schneler does not explicitly teach the % of open fabric, however Schneler clearly teaches that the lower ply is more openly woven at column 2, lines 48-49 and as to the explicit teachings of % of open fabric as claimed, the examiner's comments set forth above are sufficient. Further with respect to the applicant's argument that the openness of the layer corresponds to the thread count of 18*12 to about 9*12, said arguments are not found persuasive in determination of patentability because said arguments are not commensurate in scope with the claims. As to the applicant's arguments regarding result effective variable (claims 9-12) (page 9 of 08/16/06), the examiner is withdrawing his comments regarding a result effective variable in rejection of claims 9-12 because limitations claimed in these claims were inappropriately rejected as a result effective variable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD



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